

REMARKS

This Amendment/Response is prepared in response to the Office action mailed on 20 December 2007 (Paper No. 20071217).

Drawings

The Examiner objected to Figure 1 and required labeling this figure as "Prior Art". Applicant respectfully traverses this requirement.

Paper No. 20071217 inadequately attempts to justify this requirement with the assertion "because only that which is old is illustrated." In point-of-fact, nothing in the Code of Federal Regulations, 37 CFR §1.83 or §1.84 requires drawings of "old" structures prepared by an inventor pursuant to the requirements of 37 CFR §1.83(b) that the inventor illustrate in the drawings "so much only of the *old* structure as will suffice to show the connection of the invention therewith." Although 37 CFR §1.83(b) expressly contemplates the presence of "*old* structure" in the drawings of a U.S. Patent application, 37 CFR §1.83(b) makes no requirement that those drawings be labeled as "Prior Art." Moreover, absolutely nothing in §608.02(g) of the *Manual of Patent Examining Procedure*, 8th Edition, Rev. 5, contradicts 37 CFR §1.83(b), because nothing in §608.02(g) of the *Manual* imposes a requirement that drawings which illustrate "so much only of the *old* structure as will suffice to show the connection of the invention therewith" pursuant to 37 CFR §1.83(b) be labeled as "Prior Art."

Accordingly, there is no justification for the imposition of this requirement, and its withdrawal is respectfully requested.

Specification

The specification is objected because of the arrangement of the specification. Applicant submits a Substitute Specification herewith.

¹ 37 CFR §1.83(b).

The specification has been amended in accordance with the Examiner's suggestions set forth in the Office action (Paper No. 20071217) mailed 20 December 2007, specifically, the arrangement of the specification. In addition, the specification has been amended to include the Claim of Priority section. A substitute specification and its marked-up copy are attached to this Amendment. As stated, the amendment is made to the specification so as to improve the form only, and therefore the substitute specification includes no new matter. Entry of the accompanying substitute specification is respectfully requested.

Please note that all amendments made in the specification have been incorporated into the accompanied substitute specification. Please also note that amendments previously made in our Preliminary Amendment filed on 2 February 2005 have also been incorporated into the accompanied substitute specification. Applicants respectfully request entry of the accompanied substitute specification.

Claim Rejection Under 35 U.S.C. §102

Claims 1 through 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Seiler, US Patent No. 6,690,996 B2. Applicant respectfully traverses.

Applicant does not share the opinion of the examiner given in support of the anticipation rejection, in view of the novelty defined by the pending claims, for the following reasons.

Applicant does not share the opinion of the examiner given in support of the anticipation rejection, in view of the novelty defined by the pending claims, for the following reasons.

Applicant's independent claim 1 defines a guide means that is spatially curved and has an essentially helically designed section, and a conveyor means that is movable along the guide means. See claim 1:

“1. A conveyor-technology device for processing printed products, with a guide means and conveyor means movable along the guide means for conveying printed products which are fed by way of feed conveyors, as well as with holding means which serve for the temporary fixing of printed products in a manner such that these at least in regions may be conveyed against the effect of gravity, wherein the guide means is spatially curved and has an essentially helically designed section.”

There is no “guide means” or “conveyer means movable along the guide means” in Seiler ‘996.

Specifically, after a careful review of the first office action dated 21 December 2007 (Paper No. 20071217) and the Seiler U.S. Patent No. 6.690.996 B2 applied in support of the anticipation rejection of all pending claims, Applicant respectfully submits that in the Examiner’s analysis of the rejected claims, the Examiner mistook the ‘guide means 3’ illustrated in each of Figures 2, 3, 4, 5, 6 and 7, perhaps due to its spiral shape, as an abstract conveying path and thus equated Applicant’s ‘guide means 3’ with the ‘supply track 3’ taught by Seiler ‘669. This finding of equivalency is, in the opinion of Applicant unjustified on the basis of the teachings of Seiler ‘669 because a comparison between Applicant’s ‘guide means 3’ and Seiler ‘669’s ‘supply track 3’ is not supported by the administrative record before the Office.

By way of example, the Examiner’s attention is respectfully invited to consider paragraph [0036] of the publication of Applicant’s present application (US 2006/0231998), which carefully explains that the spiral or helical section is not formed by a drum². The Examiner is further respectfully invited to consider the following series of photographs, which graphically illustrate in a self-explanatory manner the state of the differences in the devices cited art devices.

² Paragraph [0036] of US 2006/0231998 reads: “conventional, drum-based devices, space in the inside of the drum is filled with components of the device and may **not** therefore be exploited.”

The following describes the photographs 001 through 007 set forth below:

Photograph 001 is a photograph of a conveyor-technology device as an embodiment according to the principles of the present invention;

Photograph 002 is a photograph of three conveyor means as an embodiment according to the principles of the present invention, which correspond to reference numeral 4 in Applicant's original Photograph 002;

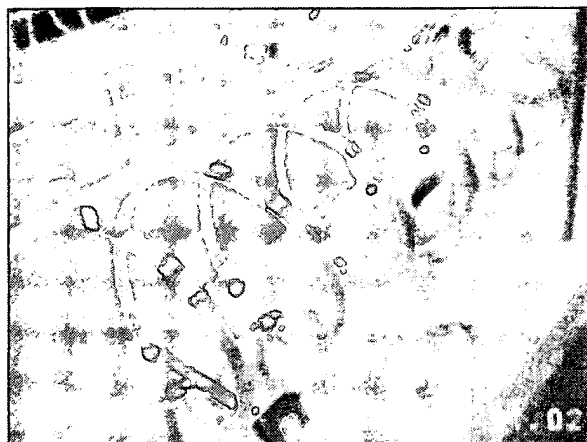
Photograph 003 is a photograph of a further guide means as an embodiment according to the principles of the present invention, which corresponds to reference numeral 9 in Applicant's original Photograph 002;

Photograph 004 is a photograph of a C-shaped section of the helical curved section of the conveyor-technology device as an embodiment according to the principles of the present invention;

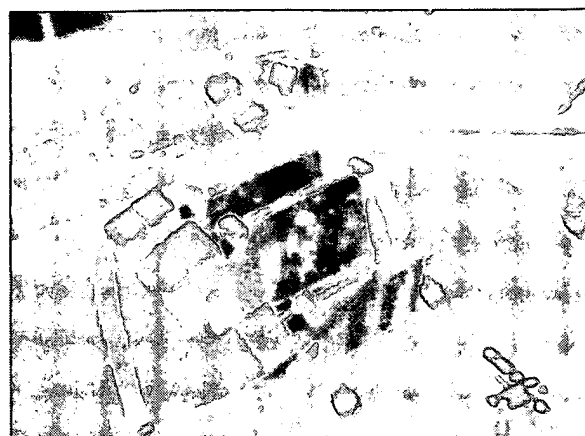
Photograph 005 is a photograph of a feed conveyor as an embodiment according to the principles of the present invention, which corresponds to reference numeral 16 in Applicant's original Photograph 002;

Photograph 006 is a photograph of another view of the conveyor-technology device as an embodiment according to the principles of the present invention; and

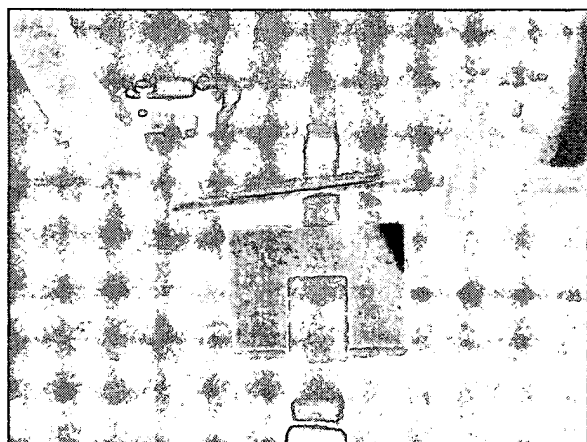
Photograph 007 is a photograph of still another view of the conveyor-technology device as an embodiment according to the principles of the present invention.



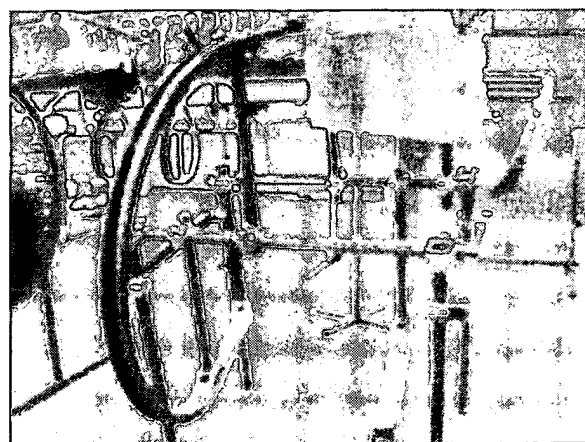
001



002



003



004



005



006



007

First, the present description discloses in paragraph [0018], along with paragraph [0015], of the publication of Applicant's present application, that 'guide means 3' are designed as rails or channels along which a plurality of 'conveyor means 4' is led. Concomitantly, paragraph [0017] teaches that the 'conveyor means 4' is understood as a plate element (claim 19), a saddle (claim 18), a pocket or a supporting rim (claim 20). In view of this disclosure, the Examiner's interpretation of Seiler '996's abstract helical portion of the conveying path as the 'guide means 3' is technically indefensible, and thus

impermissible under 35 U.S.C. §102(e) because Figure 3 of Seiler '669 is a projection view (*i.e.*, a “top view”) of the device disclosed therein. See, for example, column 4, line 46 of Seiler '669. In further distinction of the practice of Applicant's inventions defined by the rejected claims, and in contrast to the disclosure of Seiler '669, Seiler '669's printed products are not conveyed within the pocket or on the saddle of the device, as is disclosed in accordance with the principles of the present invention, and thus embodiments of these principles feature no pockets having a helical shape. Therefore, Seiler '669 fails to teach a conveyor means that is movable along the guide means to convey the printed produces, as is defined in claim 1.

Second, Seiler '669 teaches in column 6, at lines 47 through 50, that Seiler '669's 'supply track 3' comprises a drum 12 and a plurality of clock-cycle conveyors 21, 22, and 23; Seiler '669 thus unambiguously teaches the formation of a conveying path. The very same Seiler '669 teaches, in column 4, line 65 through column 5, line 6, that its supply track 3 encompasses the whole and entirety of the length covered by the conveying path which extends between article processing device 4 and processing device 8. Additionally, Seiler '669 indicates, and represents, at several occasions, *e.g.*, in column 6, lines 8 through 11, or in column 3, lines 54 through 57 of Seiler '669, that supply track 3 is advantageously implemented as a **single** circulating conveying organ having grippers.

When comparing the corresponding items of the claims of the present invention with those disclosed in Seiler '669, the Examiner must consider that it is of utmost importance to perform a correct comparison of the particular items. As mentioned in the **MPEP §2131**,

“a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”³

³ *Manual of Patent Examining Procedure*, 8th Edition, Rev. 5, §2131.

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

By a correct comparison of the particular items, the Examiner will be enabled to appreciate that the item described as 'conveyor means 4' of the present application corresponds to the 'conveying means 4' of Seiler '669, whereas the item described as 'guide means 3' in the disclosed embodiments of the present application corresponds to neither the item identified in Seiler '669 as 'supply track 3' nor with the item identified in Seiler '669 as 'completion device 2'. Hence the Examiner's denomination of the drum 12 in the draft of Figure 3 of Seiler '669 as forming the missing item 'guide means' in the same sense as that item is described in the present application, technically inaccurate, and thus factually erroneous on the administrative record before the Office.

Third, neither of the terms 'guide' or 'channel' are used in the *Detailed Description* of Seiler '669 in the descriptions of the constituent components of Seiler '669 relied upon in Paper No 20071217 to support this anticipation rejection, nor are such items shown in any one of the figures of Seiler '669. In short, Seiler '669 utterly fails to provide a person skilled in the art with a hint leading thereto.

In summation, all of the devices as defined by claims 1 through 24 in the present application are novel in comparison to Seiler '669 because the item denominated as 'guide means 3' is entirely and utterly absent from the teachings by Seiler '669.

Newly Added Claim 25

The newly added claim 25 defines a conveyor-technology device including a guide that is formed as rails or channels, and the helical curved section of the guide means is hollow inside.

First, respectfully, Seiler '996 fails to disclose the new claim 25's "helical curved section of the guide means being hollow inside". On the contrary, Seiler '996 explicitly teaches that the completion device 12 may be designed as a drum,⁴ which is solid inside. In this manner, Seiler's structure is similar to the conventional device that is discussed by Applicant's paragraph [0034], in which the inside space of the drum can not be efficiently utilized.

Secondly, Seiler '996 fails to disclose the new claim 25's rails or channels of the guide. The present description discloses in paragraph [0018], along with paragraph [0015], of the publication of Applicant's present application (US 2006/0231998), that 'guide means 3' are designed as rails or channels along which a plurality of 'conveyor means 4' is led.⁵ On the contrary, neither of the terms 'guide' or 'channel' are used in the *Detailed Description* of Seiler '669 in the descriptions of the constituent components of Seiler '669 relied upon in Paper No 20071217 to support this anticipation rejection, nor are such items shown in any one of the figures of Seiler '669. In short, Seiler '669 utterly fails to provide a person skilled in the art with a hint leading thereto.


No other issues remaining, reconsideration and favorable action upon all of the claims now present in the application is respectfully requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's undersigned attorney.

⁴ Column 7, line 11 of Seiler '996 reads: "the completion device 12 designed as a drum".

⁵ Paragraph [0018] of US 2006/0231998 reads: "Suitably designed rails or channels are suitable as guide means."

A fee for a Petition for a three month extension of time to and through the 20th of June 2008 as well as a fee for one additional total claim incurred by filing of this Amendment. A check of Applicants' undersigned attorney drawn to the order of the Commissioner in the appropriate amount accompanies this Paper. Should either the Petition or the check become lost or misplaced, the Commissioner is authorized to charge Deposit Account No. 02-3934 of Applicant's undersigned attorney, and to notify Applicant's undersigned attorney of that charge.

Respectfully submitted,


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